UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/518,766	03/03/2000	Igor Postelnik	M-8400-US	6142

33438 7590 11/26/2003	EXAMINER	
HAMILTON & TERRILE, LLP	CHANG, SABRINA A	
P.O. BOX 203518	ART UNIT	PAPER NUMBER
AUSTIN, TX 78720	3625	

DATE MAILED: 11/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _05 September 2003_ .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1,2 and 4-21_ is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1,2 and 4-21_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

   If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____ .

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

   a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Response to Amendment

Amendments to claims 1 and 2, and the addition of claims 4-21 – Originally created in

Paper 11, 11/25/02 – have been considered.

Response to Arguments

Applicant's arguments with respect to claims 1, 2, and 4-21 – stated in Paper 14, dated

8/20/03 – have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

Claim 2 is objected to under 37 CFR 1.75(c), as being of improper dependent form for

failing to further limit the subject matter of a previous claim. Applicant is required to cancel the

claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the

claim(s) in independent form.

A system disclosing multiple supplier order request management systems and a customer

order request servicing system could adequately read on the recitation of claim 2. Such a system

would not however necessarily read on the method steps of claim 1, since the system itself does

not necessarily perform the active step of selecting fulfillment partners. As a result claim 2 is an

improper dependent claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

Claims 1, 2, and 4-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Henig et al., U.S. Patent No. 6,587,827 in view of Bright et al., U.S. Patent Application

Publication U.S. 2002/0013831 A1.

Henig discloses a method and system for processing customer-generated orders to

multiple suppliers. The system of Henig is executed over a network, such as the Internet. It

includes the use of XML standards [Col 4, Line 30]. More importantly the system is focused on

bringing together customers and suppliers that may be located anywhere in the world [Col 4,

Line 4].

A customer selects a preferred supplier for delivering a particular product by using any

number of calculations including, but not limited to, available inventory of the product,

geographical area, transportation efficiencies, etc. (business rules) [Col 5, Line 48]. The system

maintains a database of all orders and forwards them to the specified supplier (splitting the order

request into multiple processed order requests wherein each processed order request includes at

least one of the items). A customer order may be for a large amount of product that may not be

available at one supplier, or may specify several different shipping destinations that may not be

convenient to a single supplier. In either event there may be more than one preferred supplier

determined to accommodate the availability constraints or the shipping destination required

(application of business rules to a multiple product order, splitting the order between different

suppliers). Once a preferred supplier is selected, the order is forwarded to that particular supplier

and the transaction is processed by the supplier system (transmission of the processed order

request to the ORMS of the fulfillment partner) [Figure 4]. The supplier (fulfillment partner)

ships the product to the customer and creates a confirmation event (receiving from the ORMSs

of the selected fulfillment partners ORMS data associated with the processed order request

transmitted to the ORMS of the fulfillment partner).

Henig does not disclose that the selection of the preferred supplier is an automatic

process conducted using electronically stored business rules and generating a "fulfillment plan".

Bright et al. teaches a method and apparatus for pre-processing electronic data requests

within an order fulfillment application system (order request servicing system). Electronic Sales

Orders (ESO) made by a customer are split into multiple requests if there are multiple line items

to be supplied by different delivery plants [Para. 17]. Primarily, the ESO is split based upon the

evaluation of third party availability to fill an order, but the order can also be split according to a

set of business rules [Para. 18]. The order interceptor also performs various edits and audits

based upon the business rules configured by the customer [Para. 23]. The interceptor system is

implemented using EDI format transmission [Para. 35].

Bright et al. does not explicitly disclose that the business rules are used to designate a

particular supplier. Essentially however, Bright et al. teaches an automated pre-processing order

system that filters a customer's order through a business rules database – the rules stored could

be of *any* nature, including preferences for selecting particular suppliers – before sending it to the

order management system.

It was known at the time of the invention that merely providing an automatic means to

replace a manual activity which accomplishes the same result is not sufficient to distinguish over

the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example,

simply automating the step selecting a preferred supplier based upon known business rules gives

you just what you would expect from the manual step as shown in Henig. In other words there is

no enhancement found in the claimed step. The electronic storage and processing of such rules

would lead to the same result as compared to the manual method. A computer can simply iterate

the steps faster.

In that the method of choosing a supplier based upon a known set of variables (business

rules) is well-known, as disclosed in Henig, it would have been obvious to automate the supplier

selection and order forwarding process using an electronically stored database of business rules,

such as the one taught in Bright et al., in order to match customers with appropriate vendors and

expedite their orders more quickly.

In specific reference to claim 10, in that the system of Henig/Bright provides for digital

data transmission between a network of computers, it would have been obvious to use any means

data transmission network (the Internet or any other distributed network), any direct

communications link (satellite, cellular or otherwise) and/or any data delivery standard (XML,

EDI or otherwise) because such differentiations in standard or communication would not lend to

an unpredictable result or an improvement to the system.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

Doyle discloses a centralized ordering system. The central supplier processes a customer

order by splitting the order form into information for individual vendors and prepares several

vendor order forms [Col 1, Line 26. Fig. 1]. When a customer places an order, the main

computer system segregates the order data, such as requisition item information, and collates that

information by individual vendors and internal departments. The appropriate requisition, or

purchase order, information is transmitted to the vendor [Col 4, Line 4]. The vendors deliver the

ordered products directly to the customer. They submit separate invoices for each completed

order to a central invoicing system. The central invoicing service prepares and submits itemized

invoices for all delivered products to the customer. The customer submits payment to the central

invoicing service, which in turn then pays the outside vendors for the products. Doyle does not

explicitly disclose however the automatic selection of a fulfillment partner based upon a set of

business rules.

Clark discloses a collective business system that operates similarly to Doyle. Clark does

not explicitly disclose however the automatic selection of a fulfillment partner based upon a set

of business rules.

Joseph et al. discloses a system for electronically ordering items via an automated

network of suppliers. Joseph et al. does not explicitly disclose however the automatic selection

of a fulfillment partner based upon a set of business rules.

Venkatesan et al. discloses a method for providing information to a customer who is

attempting to purchase a synthesized "strand". The capabilities of multiple suppliers are stored

in a database and matched with the customer's request. Venkatesan does not disclose the ability

to order a plurality of products and distribution of the order based upon the automatic selection

of a fulfillment partner based upon a set of business rules.

Hirth et al. and Eckert et al. both disclose the automated distribution and routing of orders

according to client-specified business rules. The dates on both documents renders them invalid.

Shoquist et al. discloses an automated procurement system that minimizes human

intervention. Shoquist et al. does not explicitly disclose however the automatic selection of a

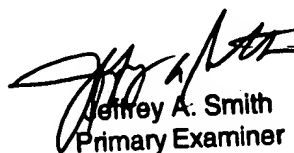fulfillment partner based upon a set of business rules.

Notani et al. discloses a workflow distribution system. Notani et al. does not disclose the

ability to order a plurality of products and distribution of the order based upon the automatic

selection of a fulfillment partner based upon a set of business rules.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Sabrina Chang whose telephone number is 703 305 4879. The

examiner can normally be reached on 8:30 am - 5:30 pm Mon.- Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Jeffrey Smith can be reached on 703 305 3588. The fax phone number for the

organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is 703 308 1113.

SC

Jeffrey A. Smith
Primary Examiner